IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	Hartmut Neven, Sr.
SERIAL NO.:	10/783,378
FILING DATE:	February 20, 2004
TITLE:	Image Based Inquiry System for Search Engines for Mobile Telephones with Inserted Camera
EXAMINER:	Nicholas Giles
GROUP ART UNIT:	2622
ATTY. DKT. NO.:	24207-12225

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Dated: February 11, 2009 By: /Christopher King/
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REPLY BRIEF

This Reply Brief is filed in accordance with 37 CFR § 41.41 in response to the Examiner's Answer, which was mailed on December 11, 2008.

Argument

A. Claims 1-8, 11-15, 17-19, and 21-28 are not anticipated by Boncyk

Independent claim 17 recites a computer implemented method for image-based searching in which a search engine provides a set of search results in response to receipt of a symbolic identifier. Specifically, claim 17 recites a computer implemented method for image-based searching, comprising:

> receiving at a computer server, an input image from a user device remotely located from the server;
> providing from the computer server the input image to an image recognition system;
> receiving at the computer server from the image recognition system a symbolic identifier associated with the input image;
> providing from the computer server the symbolic identifier **to a search engine** as a query;
> receiving at the computer server **from the search engine** a set of search results associated with the symbolic identifier; and
> transmitting from the computer server a plurality of the search results to the user device.

As claimed, a computer server provides an input image to an image recognition system and receives a symbolic identifier associated with the input image. The symbolic identifier is provided to a search engine as a query, and the computer server receives from the search engine a set of results associated with the symbolic identifier. Thus, for example, the image recognition system could identify an image of the Eiffel Tower and provide the text, e.g. "Eiffel Tower," as the symbolic identifier to the search engine. The search engine then accepts the symbolic identifier "Eiffel Tower" and in response provides a list of links to web sites containing information relating to the Eiffel Tower ("a set of search results associated with the symbolic identifier"). (*See, e.g.,* paragraph 0003 of the specification).

In his assertions that Boncyk discloses the claimed "search engine," the Examiner still

fails to address the essential fact—noted by Applicant first in the Response of January 14, 2008, and in every communication since then—that Boncyk himself admits that no search engine is disclosed. More specifically, in a later application by Boncyk himself, Application Serial No. 11/204,901, filed August 15, 2005,[1] and a continuation-in-part of Application Serial No. 09/992,942, filed November 5, 2001, Boncyk admits:

> Several years ago the present inventors pioneered the concept of using digitally captured images to identify objects within the images, and then using such identifications to retrieve information from various databases.
> . . .
> It was not appreciated, however, that one could integrate these concepts with the searching capabilities of standard Search Engines.
> . . .
> The present invention provides apparatus, systems and methods in which: . . . (c) the search criteria are submitted to a Search Engine to obtain information of interest[.] (citation, emphasis added)

Thus, Boncyk himself, as an inventor being without question one of at least ordinary skill in the relevant art, admits that the claimed use of search engines was not "appreciated"—that is, not suggested let alone "disclosed"—in his own earlier applications—including the Boncyk reference replied upon by the Examiner. As noted by the Federal Circuit, "[w]hen prior art contains apparently conflicting references, the Board must weigh each reference for its power to suggest solutions to an artisan of ordinary skill. … The Board, in weighing the suggestive power of each reference, must consider the degree to which one reference might accurately discredit another." *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991). Thus Boncyk himself expressly states in his later patent application that the integration of image identification with the searching capabilities of standard search engines was not previously contemplated by

[1] Note that the filing date of the present application is February 20, 2004, and thus precedes the filing date of Boncyk's Application Serial No. 11/204,901, the first Boncyk application to mention the use of search engines.

him, thereby discrediting his own earlier work. In this circumstance, it was clear legal error for the Examiner to substitute his own judgment as to what Boncyk WO 03/041000 discloses over the very admissions of Boncyk himself. Rather, the admissions of Boncyk Application 11/204,901 must be weighed when interpreting Boncyk WO 03/041000. These admissions—which are clearly against Boncyk's own interests—outweigh the Examiner's attempted interpretation of Boncyk WO 03/041000. Boncyk himself is the best judge of what his application WO 03/041000 discloses.

Thus, the rejection of independent claim 17 is legal error. Independent claims 1, 11, 18, and 28 all recite the use of a search engine and are rejected in a manner similar to that of claim 17. Thus, their rejections likewise constitute legal error for at least the same reasons discussed above.

B. Claims 9, 10, 16, and 20 are patentable over Boncyk and Official Notice

Claims 9, 10, 16, and 20 depend, directly or indirectly, from independent claims 1, 11, or 18, and thus their rejections constitute legal error for at least the same reasons discussed above, nor do features allegedly disclosed by the Official Notice cure the error.

C. Claims 29-31 are patentable over Boncyk and Waibel

Independent claims 29 and 31 recite the use of a search engine and were rejected in a manner similar to that of claim 17, over Boncyk in combination with Waibel. Here too, the Examiner failed to consider the admission of Boncyk Application 11/204,901. Further, the Waibel reference, cited as allegedly disclosing specific features such as text translation, no more discloses the claimed search engine than does Boncyk itself. Indeed, even the Examiner does not

suggest that Waibel discloses this claimed feature. Thus, the rejections of these claims likewise constitute legal error for at least the same reasons discussed above.

Summary

For the foregoing reasons, as well as for those previously articulated in the Appeal Brief of October 2, 2008, Appellant believes that the Examiner's rejections of claims 1-31 were erroneous, and respectfully requests that the Board reverse the rejections.

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